

U.S. Patent Application Serial No. 10/082,089
Response dated November 10, 2003
Reply to OA of July 10, 2003

REMARKS

Claims 1-4 and 6-11, are pending in this application. Claims 1-4 and 6-11, have been rejected.

Claim 1 has been amended to delete the organic pigment represented by formula 9. Claim 6 has been amended to require that the binder resin is a polyester resin. Claim 8 has been amended to remove dependency on claim 1, and to recite that the toner includes a binder resin and an organic pigment dispersed finely in the binder resin, where the pigment is an organic pigment represented by any one of formulas 3, 4, and 6-9, and the method includes in part, mixing a mixture with an aqueous medium, separating the colored particles, and drying the colored particles.

Support for the claims as amended, appears throughout the specification and claims as originally filed. No new matter has been added.

Submitted herewith, please find an English translation of the present priority document, Japanese Patent Application No: 2001-056636, dated March 1, 2001.

In view of the claims as amended, the English translation of the priority document, and the remarks set forth below, further and favorable reconsideration, is respectfully requested.

I. At page 4, paragraph 4, of the Office Action, claims 1-4 and 6-11, have been rejected under 35 USC § 112, second paragraph, as being indefinite.

The Examiner states that none of the formulas of claim 1 include the recited R groups.

Claim 1 has been amended to delete the noted passage referring to R groups.

U.S. Patent Application Serial No. 10/082,089
Response dated November 10, 2003
Reply to OA of **July 10, 2003**

In view of claim 1 as amended, it is submitted that the claims are clear and definite within the meaning of 35 USC § 112, second paragraph. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

II. At page 4, paragraph 6, of the Office Action, claims 1-4 and 6 have been rejected under 35 USC § 102 (e) as being anticipated by US 2001/0033982 A1 (Ishikawa).

The Examiner states that Ishikawa's Formula (A) in Example 3, is identical to formula 9 recited in claim 1. In view of the following, this rejection is believed to be overcome.

Anticipation under 35 USC § 102 (e) requires that a single prior art reference teach each and every element of the claimed invention.

Claim 1 has been amended to delete the organic pigment of Formula 9. Claims 2, 3, 4 and 6, are dependent on claim 1.

Further, claim 6 which is dependent on claim 1, has been amended to limit the binder resin to a polyester resin, in view of the disclosure in Example 3 of Ishikawa which recites the use of a styrene-acrylic resin.

Method claim 8 has been amended to remove dependency on claim 1, and recites that the organic pigment is represented by any one of Formulas 3, 4, and 6-9.

In view of the amendments to the claims, it is submitted that Ishikawa does not teach each and every element of the claimed invention as required for anticipation under 35 USC § 102 (e). Accordingly, the Examiner is respectfully requested to withdraw this rejection.

U.S. Patent Application Serial No. 10/082,089
Response dated November 10, 2003
Reply to OA of July 10, 2003

III. 103 REJECTIONS

- A. At page 5, paragraph 7, of the Office Action, claims 1-4, 6, and 7, have been rejected under 35 USC § 103(a) as being unpatentable over US 6, 063,537 to Nakamura, combined with US 2002/0058193 A1 to Tosaka, as evidenced by American Chemical Society (ACS) File Registry Nos. 56396-10-2, 6448-96-0, 12225-06-8, and 67990-05-0.**

The Examiner states that it would have been obvious in view of Tosaka, to use Tosaka's monoazo pigment as the magenta pigment in Nakamura's toner M-2, because the artisan would have had a reasonable expectation of successfully obtaining a magenta toner having the benefits disclosed by Tosaka.

- B. At page 7, paragraph 8, of the Office Action, claims 1-4, 6, and 7, have been rejected under 35 USC § 103(a) as being unpatentable over US 6, 063,537 to Nakamura, combined with US 2002/0037466 A1 to Kanbayashi.**

The Examiner states that it would have been obvious in view of Kanbayashi, to use Kanbayashi's mixture comprising the compound of formula (3) and the compound represented by formulas (1-3), (1-4), or (1-5), as the magenta pigment in Nakamura's toner M-2, because the artisan would have had a reasonable expectation of successfully obtaining a magenta toner having good hue and light-fastness as taught by Kanbayashi.

We note that Kanbayashi appears to disclose at col. 9, formulas I-3, I-4 and I-5 which are identical to present formulas 4 disclosed on page 19 of the Specification, formula 7 disclosed on page 20, and formula 9 disclosed on page 21, respectively.

U.S. Patent Application Serial No. 10/082,089
Response dated November 10, 2003
Reply to OA of July 10, 2003

- C. *At page 9, paragraph 9, of the Office Action, claims 1-4, 6, and 7, have been rejected under 35 USC § 103(a) as being unpatentable over US 6, 265,125 to Anno, combined with US 2002/0058193 A1 to Tosaka, as evidenced by American Chemical Society (ACS) File Registry Nos. 56396-10-2, 6448-96-0, 12225-06-8, and 67990-05-0.***

The Examiner states that it would have been obvious in view of Tosaka, to use Tosaka's monoazo pigment composition, as the magenta pigment in Anno's toner N, because the artisan would have had a reasonable expectation of successfully obtaining a magenta toner having the benefits disclosed by Tosaka.

Tosaka appears to disclose pigments CC.I. pigment Reds 31, 150, 176 and 269) which are identical to present formulas 4, 3, 6, and 9 respectively.

- D. *At page 11, paragraph 10, of the Office Action, claims 1-4, 6, and 7, have been rejected under 35 USC § 103(a) as being unpatentable over Anno, combined with Kanbayashi.***

The Examiner states that it would have been obvious in view of Kanbayashi, to use Kanbayashi's mixture comprising the compound of formula (3) and the compound represented by formulas (1-3), (1-4), or (1-5), as the magenta pigment in Anno's toner N, because the artisan would have had a reasonable expectation of successfully obtaining a magenta toner having good hue and light-fastness as taught by Kanbayashi.

U.S. Patent Application Serial No. 10/082,089
Response dated November 10, 2003
Reply to OA of July 10, 2003

E. At page 12, paragraph 11, of the Office Action, claims 8-11, have been rejected under 35 USC § 103(a) as being unpatentable over Anno, combined with Tosaka, as evidenced by American Chemical Society (ACS) File Registry Nos. 56396-10-2, 6448-96-0, 12225-06-8, and 67990-05-0, as applied to claim 1 above and further combined with US 6,183,924 to Nomura.

The Examiner states that it would have been obvious in view of Anno and Nomura, to make the toner rendered obvious over Anno and Tosaka by the emulsion dispersion granulation method disclosed by Nomura, such that the resultant toner has the roundness required by both Anno and Nomura, because the artisan would have had a reasonable expectation of successfully obtaining a magenta toner having the benefits disclosed by Anno and Nomura.

F. At page 14, paragraph 12, of the Office Action, claims 8-11, have been rejected under 35 USC § 103(a) as being unpatentable over Anno, combined with Kanbayashi, as applied to claim 1 above, further combined with Nomura.

The Examiner states that it would have been obvious in view of Anno and Nomura, to make the toner rendered obvious over Anno and Kanbayashi by the emulsion dispersion granulation method disclosed by Nomura, such that the resultant toner has the roundness required by both Anno and Nomura, because the artisan would have had a reasonable expectation of successfully obtaining a magenta toner having the benefits disclosed by Anno and Nomura.

G. In view of the following, the above rejections A-F, are believed to be overcome.

Submitted herewith, please find an English translation of the certified copy of the present Japanese priority document, Japanese Patent Application No: 2001-56636, filed March 1, 2001. This

U.S. Patent Application Serial No. **10/082,089**
Response dated November 10, 2003
Reply to OA of **July 10, 2003**

English translation is submitted in order to perfect Applicant's claim for foreign priority.

All of the pending claims including the currently amended claims, are clearly and fully supported within the meaning of 35 USC § 112, by the disclosure in the Japanese priority document.

For example, original claims 1-9 find support on pages 1-3, of the translation. The organic pigments of Formula 3-4 and 6-9, find support on pages 1, and 18-20. The polyester binder resin finds support on pages 1 and 10, of the translation. The method as claimed in claim 8, finds support at pages 2, and 31-40, of the translation..

In each of the above rejections (A-F), the Examiner has relied on either Tosaka (US 2002/0058193 A1) having an effective date of August 31, 2001, or Kanbayashi (US 2002/01037466 A1) having an effective date of June 10, 2001, in combination with other references.

The present priority application filed March 1, 2001, antedates the earliest US filing date of Tosaka and Kanbayashi. Applicant's perfected claim for foreign priority establishes invention of the subject matter of the rejected claims prior to the effective dates of Tosaka and Kanbayashi (August 31, 2001, and June 10, 2001, respectively). Accordingly, Tosaka and Kanbayashi do not constitute proper prior art against the present claims.

In view of the foregoing, it is submitted that Tosaka and Kanbayashi do not constitute prior art against the present claims. Thus, it is submitted that each of the 103 rejections A-F, are improper. Accordingly, the Examiner is respectfully requested to withdraw these rejections.

In view of the aforementioned amendments and accompanying remarks, present claims 1-4 and 6-11, are in condition for allowance, which action, at an early date, is requested.


U.S. Patent Application Serial No. **10/082,089**
Response dated November 10, 2003
Reply to OA of **July 10, 2003**

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicants undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

ARMSTRONG, KRATZ, QUINTOS,
HANSON & BROOKS, LLP


Susanne M. Hopkins
Attorney for Applicant
Reg. No. 33,247

SMH/mla

Atty. Docket No. **020232**
Suite 1000
1725 K Street, N.W.
Washington, D.C. 20006
(202) 659-2930



23850

PATENT TRADEMARK OFFICE

Enclosures: Petition for Extension of time
Translation of Priority Document

H:\FLOATERS\shopkins\02\020232\amendment nov 2003